

Customer No.: 31561
Application No.: 10/605,163
Docket No.: 10230-US-PA

REMARKS

Present Status of the Application

The Office Action mailed June 4, 2004 requires restriction and/or election to presently pending claims 1-25. In response thereto, Applicant has made an election. However, Applicant has also added new independent claim 26 generic to all figures, and argued that independent claims 18 and 26 both are allowable generic claims and an election should not be required under 35 U.S.C. 121. Accordingly, withdrawal of the restriction/election requirement is respectfully requested.

Discussion of Restriction/Election Requirement

Applicant has elected *claims 1-8 and 18-25 and new independent claim 26* as Species I, which corresponds to figures 2-5 and 7 wherein an *opening* is in the substrate. Specifically,

- 1) claims 18-25 correspond to a multi-chip structure as *the core of the MCM package* in each of figures 2-5 and 7;
- 2) claims 1-8 correspond to the *whole MCM packages* in figures 2-5 and 7, wherein *each MCM package includes a multi-chip structure of claim 18*, and a substrate having an opening therein with necessary bumps; and
- 3) new independent claim 26 differs from independent claim 1 *merely* in that a hole, which is a generic term for opening and cavity, is present in the substrate, in replacement of the

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opening in the substrate in independent claim 1. Accordingly, new independent claim 26 also *includes a multi-chip structure of claim 18.*

Since *all limitations of independent claim 18 are included in each of figures 2-5 and 7 and each of independent claims 1 and 26*, there are not two or more "independent and distinct" inventions in claims 1-8, 18-25 and 26, and claim 18 is a generic claim among claims 1-8, 18-25 and 26.

On the other hand, non-elected claims 9-17 are of Species II that corresponds to figure 6, in which a cavity is present in the substrate. The MCM package of independent claim 9 includes a multi-chip structure of claim 18, so *independent claim 9 also includes all limitations of independent claim 18.*

Nevertheless, Applicant respectfully submits that an election should not be required under 35 U.S.C. 121, since independent claims 18 and 26 both are allowable generic claims among claims 1-26. Independent claims 18 is a generic claim because it describes a multi-chip structure as the core of the MCM package in each of figures 2-7 and all limitations of claim 18 is included in *each of independent claims 1, 9 and 26*, as mentioned above. Since claims of additional species which include all the limitations of an allowable generic claim can be presented in a single application, claims 1-26 should not be divided under 37 CFR 1.141.

Moreover, new independent claim 26, which differs from independent claim 1 *merely* in that a hole instead of an opening is present in the substrate, should also be allowable and generic

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to independent claims 1 and 9 and figures 2-7, since the "hole" in the substrate in claim 26 can represent an "opening" (through hole) as in claim 1 and figures 2-5 and 7, or represent a "cavity" (blind hole) as in claim 9 and figure 6. That is, the substrate having a "hole" therein in claim 26 can represent a substrate having an "opening" (through hole) therein as in independent claim 1 and figures 2-5 and 7, or a substrate having a "cavity" (blind hole) therein as in independent claim 9 and figure 6.

In summary, each of independent claims 1 and 9 includes all the limitations of new independent claim 26, while claim 26 includes all the limitations of independent claim 18. Independent claim 18 should be allowable and generic to independent claims 1, 9 and 26 and figures 2-7, and new independent claim 26 should be allowable and generic to independent claims 1 and 9 and figures 2-7. Therefore, there are not two or more "independent and distinct" inventions in claims 1-26, and claims 1-26 should not be divided under 35 U.S.C. 121.

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CONCLUSION

Accordingly, Applicant has elected claims 1-8, 18-25 and 26 as Species I, but still submits that there are allowable claims 18 and 26 generic to independent claims 1 and 9 and figures 2-7 and no two or more "independent and distinct" inventions are included in the present application. Therefore, Applicant submits that an election should not be required under 35 U.S.C. 121, and respectfully requests withdrawal of the restriction/election requirement. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

Respectfully submitted

Date :

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